

REMARKS/ARGUMENTS

Initially, the Applicant would like to thank the Examiner for the courtesies extended the Applicant's representative during a telephone interview conducted February 20, 2008. During the interview, the Examiner stated that she would consider entering claim amendments to overcome the § 112 rejection and the § 1.131 affidavits to remove U.S. Patent Application Publication No. 2004/0109933 to Roy et al. as prior art.

Presently, claims 1, 3-9, 14-17, 32, 38 and 81 stand rejected by the Examiner as being anticipated by U.S. Patent Application Publication No. 2004/019933 to Roy et al. Two § 1.131 affidavits are provided herewith, each of which establishes a reduction to practice of the present invention prior to the prior art date of October 31, 2003 in Roy et al, thereby removing Roy et al. as prior art.

Regardless of the §1.131 affidavits, the Applicant continues to maintain that Roy et al. is not an anticipating reference. The present invention is directed to a **soft dried** marshmallow. Importantly, the present invention provides for a marshmallow that is dried and shelf stable, but is also soft in texture, even when immersed in a cold fluid. The novel physical aspects of the present invention are quantified using glass transition temperature (T_g) and springback factor limitations. The Examiner admits that Roy et al. does not explicitly disclose or teach either of these limitations, but rather holds that the limitations are inherent "as Roy teaches a **similar** confection with the instantly claimed softening agent within the instantly claimed range, it would be **expected** that Roy inherently teaches [of] a product that has a glass transition temperature and spring back factor as instantly claimed" (emphasis added). To counter this position, the Applicant respectfully submits that the Examiner is incorrect in both the application of the law and what the Examiner holds in taught by Roy.

The Applicant will admit that the Examiner is correct to the extent that an inherent feature can be relied upon for an anticipatory rejection. As set forth in MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is

found, either expressly or inherently described, in a single prior art reference.” However, note that the inherent feature must be “inherently described.” The fact that a prior art article **may** inherently have the characteristics of the claimed product is not sufficient for anticipation. *Ex parte Skinner* (BPAI) 1986) 2 PQ2d 1788. Inherency must be a necessary result and not merely a possible result. *In re Oelrich* (CCPA) 1981 666 F2d 578, 212 USPQ 323. It is submitted that the features referenced by the Examiner as being inherent are not at all described in Roy. This point will be expanded upon below. In addition, MPEP 2131.03 outlines that “Anticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.” Roy does not, in any way, disclose exactly what is claimed.

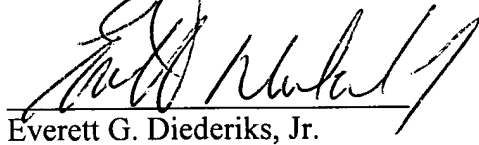
For support of the rejection, the Examiner refers back to the Office Action of April 24, 2007. Particular reference is made to page 6, lines 7-15 wherein the Examiner holds that Example 1 in Roy teaches an aerated confection with a 79% saccharide component, including 59% sucrose, about 11% corn syrup, and about 9% dextrose, then indicates that paragraph 0010 of Roy teaches to replace the dextrose with glycerin, thereby resulting in 9% glycerin which is a softening agent. Although the Applicant will admit that glycerin can function as a softening agent, not only could the Applicant not find support for the 79, 59, 11 and 9% ingredients in Roy, particularly Example 1 referenced by the Examiner, but paragraph 0010 does not teach to directly replace dextrose with glycerin. Instead, paragraph 0010, at best, states: “The sucrose solution can also be made without corn syrup, dextrose, or both, using instead maltose, lactose, glycerin, maltodextrin, a glucose syrup, or mixtures thereof.” Not only could the Applicant not find the referenced teaching to 9% dextrose in Example 1 identified by the Examiner, but paragraph 0010 does not expressly teach a 1:1 direct interchangeability of dextrose and glycerin such that it is unclear how the Examiner arrived at the clearly anticipatory teaching in Roy to provide 9% glycerin.

The Examiner has further rejected claims 10-13, 19, 20, 22, 27, 27-31 and 81 under 35 U.S.C. 103(a) as being unpatentable over Roy et al. in view of U.S. Patent No. 6,309,686 to Zietlow; claims 16-18, 21, 23, 25, 26 and 33 as being unpatentable over Roy et al. in view of U.S. Patent No. 6,207,216 to Zietlow; claims 34 and 35 as being unpatentable over Roy et al. in view of '216 to Zietlow and Igoe; and claims 37 and 39 as being unpatentable over Roy et al. in view of '216 to Zietlow, Igoe and U.S. Patent No. 4,251,561 to Gajewski. Again, the enclosed §1.131 affidavits effectively remove Roy et al. as prior art. Regardless, the Applicant continues to maintain that the Examiner has failed to show a prima facie case of obviousness in rejecting the above-claims. More specifically, Roy et al. does not teach glass transition temperature or springback factor required in claim 1. In fact, none of the cited references teach the glass transition temperature or springback factor of the present invention. Further, '216 to Zietlow et al. is directed to a dried, **crisp, frangible** marshmallow, which clearly teaches away from a **dried soft** marshmallow having a softening agent sufficient to provide a **glass transition temperature of less than 5° C or the recited springback factor**, as is required by the present invention.

Based on the above remarks, amendment to the claim 29 and the enclosed § 1.131 affidavits, the Applicant respectfully submits that the present invention is patentably defined over the prior art of record such that entry of this amendment/response, withdrawal of the Roy et al. reference as effective prior art, allowance of all claims and passage of the application to issue are respectfully requested. If the Examiner feels that the Affidavit should not be entered at this time, and continues to disagree with the Applicant regarding the 35 U.S.C. § 102 and 103 rejections, the Applicant respectfully requests that the amendment to claim 29 be entered and the 35 U.S.C. § 112 rejections be withdrawn for purposes of appeal.

If the Examiner would like to discuss the points raised above, such as particularly explaining to the undersigned the support in Roy for the positions taken, in order to further expedite the prosecution, she is cordially invited to contact the undersigned at the number provided below. Certainly, the Examiner's reconsideration on these matters is appreciated.

Respectfully submitted,



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Date: February 27, 2008
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